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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,011	02/12/2001	David Leigh Donoho	UNIV0001D2-C	2182
22862 7590 06/19/2009 GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			EXAMINER CHOUDHURY, AZIZUL Q	
			ART UNIT 2445	PAPER NUMBER
			MAIL DATE 06/19/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/782,011

Applicant(s)

DONOHO ET AL.

Examiner

AZIZUL CHOUDHURY

Art Unit

2445

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 7, 9-12, 21-28 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) 1, 5, 21-28 and 35-37 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 6, 2009 has been entered.

Response to Amendment

The affidavit filed on April 6, 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hemphill (6,167,448) and Ahmad (6,029,258) references.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hemphill (6,167,448) and Ahmad (6,029,258) references to either a constructive reduction to practice or an actual reduction to practice. Exhibit C of the affidavit evidence clearly shows that work began on the product on January 1, 1998. However the affidavit states that conception of the idea began on September 17, 1997. There is no evidence of due diligence taking place between September 17, 1997 and January 1, 1998.

Allowable Subject Matter

Claim 12 is allowed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hemphill et al (US Patent No: 6,167,448) in view of Ahmad (US Patent No: 6,029,258).

1. Regarding claim 7, Hemphill further discloses through Ahmad, a computer implemented inspector for inspecting any of the properties of a computer, said computer's configuration, contents of said computer's storage devices, said computer's peripherals, said computer's environment, or remote affiliated computers, said inspector comprising: an inspector library containing code written in an extensible and non-procedural language using no function calls with variable arguments [Hemphill, column 1, lines 40-48], which is invoked as part of a continual relevance evaluation process, executing on said consumer's computer [Hemphill, column 1, lines 33-51 and]; wherein said inspector is configured to automatically and without receiving consumer's input

query at least one physical device communicatively coupled to said consumer's computer, in order to glean property information concerning said consumer's computer, wherein said inspector does not inspect a printer of said computer's peripherals [Hemphill, column 4, lines 6-57]; one or more automatic unattended inspector methods for performing any of mathematic-logical calculations, executing computational algorithms, returning the results of system calls, accessing the contents of storage devices, and querying devices or remote computers [Hemphill, column 4, lines 58-65], wherein a one way membrane allows said inspector methods to view a relevant advisory without divulging user's identity

While Hemphill's disclosure teaches network monitoring systems detecting network device properties, it does not explicitly teach automatically monitoring nor does it teach keeping the user's identity confidential. In the same field of endeavor, Ahmad teaches how troubleshooting can be performed automatically; col. 13, lines 9-12, Ahmad. Plus Ahmad teaches a system that monitors remote devices; column 5, lines 20-43 and column 13, lines 40-55, Ahmad. Plus Ahmad teaches how user identity is not obtained from the user's machine; see Ahmad, col. 7, line 69 – col. 8, line 26 and col. 10, lines 30-43. The automatic and confidential monitoring of networked devices is useful in allowing others to resolve device issues. Therefore, it would have been obvious to one skilled in the art, during the time of the invention to combine the teachings of Hemphill with those of Ahmad, to provide a system for automatically and adaptively monitor and resolve network device problems [column 5, lines 20-43, column 13, lines 40-55 and col. 13, lines 9-12, Ahmad].

2. Regarding claim 9, Hemphill further discloses through Ahmad, sending certain relevance clauses to a remote location; evaluating the clauses; and returning the clauses after a user is made aware of what is being transferred; wherein properties of the remote location are learned [see column 13, line 62 – column 14, line 6 and Ahmad, col. 6, lines 36-67 and col. 9, lines 44-63].
3. Regarding claim 10, Hemphill discloses through Ahmad the apparatus wherein properties which can be learned are an arbitrary combination of elementary properties that are determined according to basic calculations [see column 13, line 62 - column 14, line 6, Hemphill and Ahmad, col. 6, lines 36-67 and col. 9, lines 44-63].
4. Regarding claim 11, Hemphill discloses through Ahmad the said inspector library further comprising any of: a declaration of a Phrase to be used in a relevance language; an association of said Phrase to a specific method; a declaration of a new data type to be used in an evaluation process; a declaration of a calling prototype of said specific method, including a number and required data types of arguments to be supplied to said specific method; a declaration of a result data type of said specific method; an implementation of said specific method in executable form; a declaration of special hooks associating code to be called on events; a declaration of special hooks associated with creation and maintenance of special caches associated with said

specific method; and an implementation of special event methods and cache methods in executable form [see column 1, lines 53-65, Hemphill].

5. The obviousness motivation applied to claim 7 is applicable to its respective dependent claims.

Response to Arguments

Applicant's arguments filed April 8, 2009 have been fully considered but they are not persuasive. In lieu of the terminal disclaimer, the double patenting rejection has been withdrawn. However, the applicant's affidavit is not deemed persuasive. As stated above, exhibit C of the affidavit evidence clearly shows that work began on the product on January 1, 1998. However the affidavit states that conception of the idea began on September 17, 1997. There is no evidence of due diligence taking place between September 17, 1997 and January 1, 1998. For this reason, the affidavit cannot be accepted at this time and the prior arts previously issued are still applicable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AZIZUL CHOUDHURY whose telephone number is (571)272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C./
Examiner, Art Unit 2445

/VIVEK SRIVASTAVA/
Supervisory Patent Examiner, Art Unit 2445